

Remarks:

Reconsideration of the application is requested.

Claims 1-10 and 12 remain in the application. Claims 1, 6, 10, and 12 have been amended. Claim 11 has been cancelled.

In item 1 on page 2 of the above-identified Office action, the Examiner has stated that a substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because of the large number of changes to the specification contained in the papers filed on February 21, 2003 and March 5, 2003. Per the Examiner's request enclosed herewith are a replacement specification and a marked-up version of the replacement specification. No new matter has been added.

In item 2 on page 2 of the Office action, claim 6 has been objected to because of the following informalities.

More specifically, the Examiner has stated that there is insufficient antecedent basis for the limitation of "said first-mentioned roller". Claim 6 has been amended so as to facilitate prosecution of the application, and now reads "said roller". Therefore, the objection by the Examiner has been overcome.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In item 4 on page 3 of the Office action, claims 1, 3, 4, and 8-12 have been rejected as being obvious over Jeschke et al. (U.S. Patent No. 4,089,264) (hereinafter "Jeschke") in view of Rambauser (U.S. Patent No. 4,699,055) under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claim 11 of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 10, and 12 call for, *inter alia*:

a spaced-away position of said metering element in which said metering element is lifted to an outlet height of at least 20 micrometers and less than 40 micrometers from said roller.

The Jeschke reference discloses an outlet height of 0.3mm or 300 micrometers (column 4, line 4).

The reference does not show or suggest a spaced-away position of said metering element in which said metering element is lifted to an outlet height of at least 20 micrometers and less than 40 micrometers from said roller, as recited in claims 1, 10, and 12 of the instant application. The outlet height disclosed in the instant application is 20-40 micrometers, and thus is smaller than the outlet height disclosed in Jeschke by a factor of 10.

On page 5 of the Office action the Examiner comments that one having ordinary skill could easily determine the optimum range of the outlet height in the course of routine experimentation. Applicant respectfully disagrees with the Examiner. While a person of ordinary skill in the art might consider outlet heights which only slightly deviate from the 300 micrometers disclosed by Jeschke, a person of ordinary skill in the art starting at the teaching of Jeschke would never consider outlet heights which deviate in the extreme manner as in

claims 1, 10, and 12 of the instant application (i.e. by a factor of 10).

Furthermore, regarding claim 12 the following comments are made.

Claim 12 calls for, *inter alia*:

an oscillation device assigned to said metering element for mounting said metering element so that it is oscillatable at a frequency within a range of 200 Hz to 10 kHz between an engaging position and a spaced-away position of said metering element.

Applicant respectfully disagrees with the Examiner's comments on page 5 of the Office action, that it would have been obvious to one of ordinary skill in the art to determine that the optimum oscillating frequency range would be within the range of 200 Hz to 10 KHz. The oscillating frequency range of 200 Hz to 10 KHz for the metering element disclosed in the instant application is very high and Jeschke is silent with regard to any frequency values. Jeschke only discloses that it is advantageous to reduce the stroke frequency, especially for low speed machines (column 2, line 35-37).

Therefore, Jeschke provides no teaching or motivation to provide the oscillating frequency of 200 Hz to 10 KHz disclosed in the instant application.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999).

Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id.

However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed

in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate

patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 1 is believed to be allowable, dependent claims 3, 4, and 8-10 are believed to be allowable as well.

In item 5 on page 5 of the Office action, claims 2 and 5 have been rejected over Jeschke (U.S. Patent No. 4,089,264) in view of Rambauser (U.S. Patent No. 4,699,055) and further in view of Cappel et al. (U.S. Patent No. 3,913,479) under 35 U.S.C. § 103. Cappel et al. do not make up for the deficiencies of Jeschke and Rambauser. Since claim 1 is believed to be allowable, dependent claims 2 and 5 are believed to be allowable as well.

Even though claim 2 is believed to be allowable, further discussion of claim 2 is given below. The metering bar (75) disclosed in Cappel allows an adjustment of the ink quantity by zones. However, the metering bar (75) does not oscillate.

Since the metering bar (75) of Cappel does not oscillate, Cappel cannot teach an oscillating direction. At most, Cappel teaches a radial adjustment direction of the metering bar. However, the radial adjustment direction of the metering bar disclosed by Cappel is completely different than the oscillating direction disclosed in claim 2 of the instant application. Therefore, the Examiner's comment on page 6 of the Office action, that Cappel teaches an oscillating direction, is not accurate.

In item 6 on page 6 of the Office action, claim 6 has been rejected over Jeschke (U.S. Patent No. 4,089,264) in view of Rambauser (U.S. Patent No. 4,699,055) and in further view of Olawsky et al. (U.S. Patent No. 5,842,416) under 35 U.S.C. § 103. Olawsky et al. do not make up for the deficiencies of Jeschke and Rambauser. Since claim 1 is believed to be allowable, dependent claim 6 is believed to be allowable as well.

In item 7 on page 7 of the Office action, claim 7 has been rejected over Jeschke (U.S. Patent No. 4,089,264) in view of Rambauser (U.S. Patent No. 4,699,055) and in further view of Uera et al. (U.S. Patent No. 5,603,262) under 35 U.S.C. § 103. Uera et al. do not make up for the deficiencies of Jeschke and Rambauser. Since claim 1 is believed to be allowable, dependent claim 7 is believed to be allowable as well.



It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

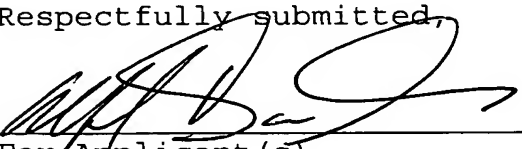
In view of the foregoing, reconsideration and allowance of claims 1-10 and 12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

  
For Applicant(s)

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